

REMARKS

The Pending Claims

Claims 1-10 are currently pending. Claims 1-8 are directed to a negative-working heat-sensitive material for making a lithographic printing plate by direct-to-plate recording. Claims 9-10 are drawn to a direct-to-plate method of making a lithographic printing plate. Reconsideration of the pending claims is respectfully requested.

Summary of the Office Action

Claims 1-2, 4-7, 9 and 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by DeBoer (*i.e.*, WO 99 19143). Claims 3 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over DeBoer in view of Van Damme et al. (*i.e.*, U.S. Patent No. 6,399,276).

Discussion of the Anticipation and Obviousness Rejections

The anticipation and obviousness rejections are predicated on DeBoer, alone or in combination with Van Damme et al. The present invention (as defined by the pending claims), however, is quite different from DeBoer and Van Damme et al., alone or in combination, and there is no suggestion in DeBoer or Van Damme et al. as to how to modify the DeBoer and Van Damme et al. disclosures to achieve the present invention.

DeBoer is directed to a lithographic printing plate made by coating a support web with a coextensive ink receptive photothermal conversion layer and then overcoating with an ink repellant layer comprising a cross-linked polymeric matrix containing a colloid of an oxide or a hydroxide selected from a group of metals, along with a photothermal conversion material. The Office alleges that a "sulfonic acid surface modified carbon meets the present limitations for the organic compound of formula (II)" (Office Action, page 3). The Applicants disagree. Put simply, carbon black consists of *elemental carbon* (see, "pigment" (b), HACKER'S CHEMICAL DICTIONARY, 3rd Ed., McGraw-Hill Book Co., Inc. (1944) at page 659), as distinguished from organic compounds which are based on *carbon chains or rings and also containing hydrogen with or without oxygen, nitrogen or*

other elements (see, DICTIONARY OF SCIENTIFIC AND TECHNICAL TERMS, 4th Ed., McGraw-Hill Book Co., Inc. (1989) at page 1334). As such, carbon black is essentially based only on *carbon atoms*, whereas, on the contrary, an organic compound is essentially based on *carbon and hydrogen atoms*. Therefore, for an ordinarily skilled artisan, a pigment such as carbon black cannot be considered as a macromolecular organic radical.

In support of its argument, the Office states "Carbon is an organic element and organic chemistry is the study of carbon compounds" (Office Action, page 6). This is simply insufficient to support the Office's argument that elemental carbon anticipates an organic compound. Quite simply, following this line of reasoning, *any* organic compound would be anticipated, or at least rendered obvious, by elemental carbon. The fact that an invention comprises a combination of known methods and or known starting materials does not defeat the right to a patent grant. See, generally, *Fromson v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 1556, 1556 n.3 (Fed. Cir. 1985) ("There is no basis in the law, however, for treating combinations of old elements differently in determining patentability;" "Only God works from nothing. Men must work with old elements") (citations omitted); *Rosemount, Inc. v. Beckman Instruments, Inc.*, 727 F.2d 1540, 1546 (Fed. Cir. 1984) ("a combination may be patentable whether it be composed of elements all new, partly new, or all old"). Nothing in the record suggests that the Boer contemplated the use of organic compounds – the disclosure is limited to the use of carbon black (*i.e.*, elemental carbon). Merely pointing to "organic chemistry" as "the study of carbon compounds" cannot be sufficient to make the leap from "carbon black" to the claimed organic radicals. As such DeBoer cannot be said to teach or fairly suggest the use of the organic radicals as recited in the claims of the present application.

The Office's reliance on Van Damme et al. is also misplaced. Van Damme et al. is, at best, prior art under 35 U.S.C. § 102(e). However, Van Damme et al. was commonly owned at the time of the present invention (see attached Statement of Common Ownership). Accordingly, Van Damme et al. may not be relied upon as a basis for a rejection under 35 U.S.C. § 103(a) (see 35 U.S.C. § 103(c)). Applicants note that Van Damme et al. nevertheless fails to remedy the shortcomings of Boer et al. to teach or

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fairly suggest the claimed organic radicals as employed in the present inventive compositions and methods.

In view of the foregoing, the rejections under 35 U.S.C. §§ 102(b) and 103(a) are improper and withdrawal of the rejections is respectfully requested.

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STATEMENT OF COMMON OWNERSHIP

The Van Damme et al. is assigned to Agfa Gevaert and was assigned to or subject to an obligation of assignment at the time the invention claimed in the present application was made. Applicants note that Van Damme et al. indicates Agfa Gevaert as assignee on its face. Furthermore, the present invention was subject to an obligation of assignment at the time the invention was made. Applicants direct the Office's attention to the recordation of assignment of the present application to Agfa Gevaert, as recorded by the Office on February 1, 2002. In view of the foregoing, Van Damme et al. and the present application were "commonly owned" by Agfa Gevaert at the time of invention of the subject matter of the pending claims.

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Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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Date: October 3, 2003